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REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner rejects claims 1, 4-6 and 16 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,547,721 to Higuma et al., (hereinafter "Higuma"). Furthermore, the Examiner rejects claims 1, 4-6, 16 and 17 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,608,270 to Donofrio et al., (hereinafter "Donofrio"). Lastly, the Examiner rejects claims 1-5, 16 and 17 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,658,238 to Suzuki et al., (hereinafter "Suzuki") in view of U.S. Patent No. 4,021,630 to Taylor (hereinafter "Taylor").

In response, independent claim 1 has been amended to clarify its distinguishing features. Independent claim 1 now recites that "the switch and the presser are arranged to be distant from each other by a predetermined distance, the predetermined distance being set longer than a distance the presser moves when the presser is loaded with a preset first pressing force due to pressurization upon autoclaving, the predetermined distance further being set such that the switch is pressed by the movement of the presser when the presser is loaded with a preset second pressing force that is larger than the preset first pressing force." The amendment to independent claim 1 is fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the present amendment to independent claim 1. Dependent claims 4 and 5 have also been amended to be consistent with amended claim 1.

The endoscope of claim is configured to be suitable for autoclaving. In this regard, the distance between the switch and the presser is set loner than the distance the presser moves when subjected to a first pressing force, e.g., a force due to pressurization upon

autoclaving. Therefore, the switch and the presser are prevented from coming in contact with each other due to the first pressing force (e.g., the force due to pressurization upon autoclaving). However, upon the exertion of a second pressing force, greater than the first pressing force (e.g., during normal operation such as being depressed by a user) the presser moves such that the switch can be pressed and operated. Claim 1 has been amended to clarify such a configuration.

In contrast, the cited references disclose a switch having a gap between the presser and switch that is provided only to prevent accidental activation of the switch (e.g., in case a finger of the user accidentally touches the button having the presser therein). None of the references disclose or suggest preventing the switch from being turned on due to pressurization upon autoclaving.

With regard to the rejections of claims 1-6, 16 and 17 under 35 U.S.C. § 102(e), an endoscope having the features discussed above and as recited in independent claim 1, is nowhere disclosed in either Higuma or Donofrio. Since it has been decided that “anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,”<sup>1</sup> independent claim 1 is not anticipated by either Higuma or Donofrio. Accordingly, independent claim 1 patentably distinguishes over both Higuma and Donofrio and is allowable. Claims 4-6, 16 and 17, being dependent upon claim 1, are thus at least allowable therewith.

With regard to the rejection of claims 1-5, 16 and 17 under 35 U.S.C. § 103(a), independent claim 1 is not rendered obvious by the cited references because neither the Suzuki patent the Taylor patent, whether taken alone or in combination, teach or suggest an

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<sup>1</sup> Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

endoscope having the features discussed above. Accordingly, claim 1 patentably distinguishes over the prior art and is allowable. Claims 4, 5, 16 and 17, being dependent upon claim 1, are thus allowable therewith.

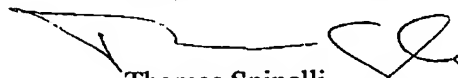
Furthermore, in the previous Response, the Applicant respectfully requested that the Examiner withdraw the Donofrio reference because the priority date of the present application (August 28, 200) is earlier than the effective filing date of Donofrio (October 20, 2000). Thus Applicants concluded that Donofrio is not a proper reference to be applied against the claims of the present application. In the Final Official Action, the Examiner does not response to such request. Thus, Applicants Again request that the rejection of claims 1, 4-6, 16 and 17 under 35 U.S.C. § 102(e) as being anticipated by Donofrio be withdrawn.

Lastly, new claims 18-25 have been added to further define the patentable invention. New claims 18-25 are fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the addition of new claims 18-25. Applicants respectfully submit that new claims 18 and 19 are at least allowable as depending upon an allowable base claim (1). Applicants further submit that new independent claim 20 patentably distinguishes over the prior art and is allowable and that claims 21-25 are at least allowable as being dependent therefrom.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone

conference with Applicant's attorneys would be advantageous to the disposition of this case,  
the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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